

### **REMARKS / ARGUMENTS**

Claims 42-59 are pending in this application. By this Amendment, Applicants amend the title of the invention and claims 42 and 57, and cancel claims 60-89.

Applicants affirm the election of Group I, including claims 42-59. Claims 60-89 have been canceled as being directed to a non-elected invention. Applicants reserve the right to file a Divisional Application in order to pursue prosecution of non-elected claims 60-89.

Applicants' representatives greatly appreciate the Examiner extending the courtesy of the personal interview on July 27, 2006. During the personal interview, the Examiner agreed to withdraw the rejection of claims 51, 54, and 55 under 35 U.S.C. § 112, second paragraph, and tentatively agreed that the spread suppressing members (2, 11) of Mori et al. (U.S. 4,603,065) extend entirely across the alleged base member (1).

Claims 51, 54, and 55 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner alleged that it was not clear what is intended by "the range." The Examiner has voluntarily withdrawn this rejection as claims 51, 54, and 55 clearly set forth what is encompassed by the claimed ranges.

Claims 42-50, 52, and 53 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mori et al. (Applicants note that the Examiner appears to discuss claim 56 in the fourth full paragraph on page 4 of the Office Action, but did not include claim 56 in the introductory paragraph.) Claims 51, 54, 55, and 57-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori et al. Claim 59 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori et al. in view of Kalana (U.S. 2002/0003696). Applicants respectfully traverse the rejections of claims 42-59.

Claim 42 has been amended to recite:

A decorative sheet comprising:  
a base member having first and second principal surfaces opposed to each other;  
a decoration layer provided on the first principal surface of the base member and having a pattern area representing a predetermined pattern;  
and

a spread suppressing member provided at a location corresponding to the pattern area on the side of the first principal surface or on the side of the second principal surface of the base member, for suppressing the spreading of the pattern area of the decoration layer; wherein  
**the spread suppressing member is arranged so as to overlap only a portion of the base member.** (emphasis added)

Applicants' claim 57 recites features that are similar to the features recited in Applicants' claim 42, including the above-emphasized feature.

With the unique combination and arrangement of features recited in Applicants' claims 42 and 57, including the feature of "the spread suppressing member is arranged so as to overlap only a portion of the base member," Applicants have been able to provide a decorative sheet such that the spread of a pattern region is suppressed, the deformation of the pattern is prevented, and the appearance of the pattern is greatly improved (see, for example, the paragraph bridging pages 18 and 19 in Applicants' originally filed specification).

The Examiner alleged that Mori et al. teach a decorative sheet as recited in Applicants' claims 42 and 57, including spread suppressing members (2, 11).

Applicants' claims 42 and 57 have been amended to recite the feature of "the spread suppressing member is arranged so as to overlap only a portion of the base member." Support for this feature is found, for example, in lines 4-9 on page 19 of Applicants' originally filed specification and Fig. 1(a) of Applicants' originally filed drawings.

Mori et al. show in Fig. 2 a semitransparent thin film (2) extending entirely across the alleged base member (1). Thus, Mori et al. clearly fail to teach or suggest the feature of a spread suppressing member wherein "the spread suppressing member is arranged so as to overlap only a portion of the base member," as recited in Applicants' claims 42 and 57.

Furthermore, it would not have been obvious to one of ordinary skill in the art to modify the semitransparent thin film (2) of Mori et al. so as to overlap only a portion of the alleged base member (1). The semitransparent thin film (2) of Mori et al. functions

to reflect light coming from the front of the decorative part and pass light coming from the rear of the decorative part (see, for example, lines 27-56 of column 2 of Mori et al.). It is critical to the invention of Mori et al. that the semitransparent thin film (2) extends entirely across the alleged base member (1) so as to reflect all of the light coming from the front of the decorative part so that the character (B) is not visible during the daytime (see, for example, lines 9-17 of column 5 of Mori et al.). If the semitransparent thin film (2) of Mori et al. did not extend entirely across the alleged base member (1), then portions of the character (B) would be visible during the daytime thus defeating the unique characteristics of the decorative part of Mori et al. in which only the character (A) is visible during the daytime, and only the character (B) is visible at night.

Mori et al. also teach a frame (11) extending entirely behind the alleged base member (1) and enclosing the ends of the alleged base member (1). Thus, Mori et al. clearly fail to teach or suggest the feature of a spread suppressing member wherein “the spread suppressing member is arranged so as to overlap only a portion of the base member,” as recited in Applicants’ claims 42 and 57.

Furthermore, the decorative part of Mori et al. would be inoperable if the frame (11) did not extend entirely across the alleged base member (1) because the frame (11) accommodates and holds all of the elements of the decorative part together.

The Examiner is reminded that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and MPEP § 2143.01.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 42 under 35 U.S.C. § 102(b) as being anticipated by Mori et al., and the rejection of claim 57 under 35 U.S.C. § 103(a) as being unpatentable over Mori et al.

The Examiner relied upon Kalana to allegedly cure deficiencies of Mori et al. However, Kalana clearly fails to teach or suggest the feature of “the spread suppressing member is arranged so as to overlap only a portion of the base member,” as recited in

Applicants' claims 42 and 57. Thus, Applicants respectfully submit that Kalana fails to cure the deficiencies of Mori et al. described above.

Accordingly, Applicants respectfully submit that Mori et al. and Kalana, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicants' claims 42 and 57.

In view of the foregoing amendments and remarks, Applicants respectfully submit that claims 42 and 57 are allowable. Claims 43-56, 58, and 59 depend upon claims 42 and 57, and are therefore allowable for at least the reasons that claims 42 and 57 are allowable.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicants petition the Commissioner for a ONE-month extension of time, extending to August 21, 2006 (August 19, 2006 falls on a Saturday), the period for response to the Office Action dated April 19, 2006.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Dated: August 9, 2006

/Stephen R. Funk #57,751/  
Attorneys for Applicant(s)

**KEATING & BENNETT, LLP**  
8180 Greensboro Drive, Suite 850  
Tyson's Corner, VA 22102  
Telephone: (703) 637-1480  
Facsimile: (703) 637-1499

Joseph R. Keating  
Registration No. 37,368

Stephen R. Funk  
Registration No. 57,751